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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,728	01/23/2006	Wenquan Fang	SZ001-04	3184

65584 7590 02/14/2008

BARRON & YOUNG INTELLECTUAL PROPERTY
HKPC BUILDING, 5TH FLOOR
78 TAT CHEE AVENUE
KOWLOON,
HONG KONG

EXAMINER
MI, QIUWEN

ART UNIT	PAPER NUMBER
1655	

MAIL DATE	DELIVERY MODE
02/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/518,728	FANG, WENQUAN	
	Examiner	Art Unit	
	QIUWEN MI	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____is/ are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims Pending

Claims 1-10 are pending. Claims 1-10 are examined on the merits.

Claim Rejections –35 USC § 112, 2nd

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 recite "every 100 dose of the medicine", and it is not clear what Applicant means by that. Thus, the metes and bound of those claims are uncertain, and the lack of clarity renders the claims very confusing and ambiguous.

Applicant is suggested to change "abstraction" (claim 8, line 4; claim 9, line 4) to "extraction".

All other cited claims depend directly or indirectly from rejected claims and are, therefore, also, rejected under U.S.C. 112, second paragraph for the reasons set forth above.

Claim Rejections –35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Zuo (WO 01/76613 A1), Kim (US 4,696,818), Wen (US 5,198,230), Zhou (US 6,416,806), Oh (KR 2000072102), and Chang et al (US 5,552,404).

Zuo teaches a composition has effects on helping narcotic addicts to abstain physiological dependency and psychological dependency comprising root of *Panax ginseng*, root of *Aconitum carmicharli* Debx, skin (stem bark) of *Cinnamomum cassia*, stem (tube) of *Corydalis turtschaninovii*, root of *Salvia militorrhiza*, *Ziziphus jujuba* Mill, and root of *Glycyrrhiza uralensis* (see Abstract, full translation has been ordered). Zuo also teaches that *Ziziphus jujube* "ren" (seed) is part that is being used (see Chinese Abstract). Zuo further teaches that the composition can be in the pharmaceutical forms, such as tablet, powder, capsule, decoction, and injections, with carriers/excipients (page 5, lines 1-10). At last Zuo teaches extracting volatile oils from raw materials such as *Cinnamomum cassia* with conventional water distillation (page 6, last paragraph), and extracting raw materials using water decoction (page 6, 1st paragraph), and 70% ethanol reflection (page 6, 3rd paragraph).

Zuo does not teach a composition with the incorporation of *Angelica polymorpha, Cyperus rotundus, Paeonia lactiflora, Schizandra chinensis, and* Tween 80 into the composition.

Kim teaches a composition for treatment during withdrawl from drug dependency comprising Radix (root) *Angelica sinensis* (synonym of *Angelica polymorpha*), and *Cyperus rotundus*.

Wen teaches a composition for the treatment of addictive disease comprising *Buthus martensii* kirsch and *Aconitum carmichaeli* etc (col 2, lines 45-50).

Zhou teaches a composition for caffeine addiction comprising extracts *Paeonia lactiflora*, and Schizandra (the same as *Schizandra chinensis* fruit).

Oh teaches a composition for stop smoking (narcotic addiction) comprising *Amomum villosum* (see Abstract, full translation has been ordered).

Chang et al teach a composition for treating drug addiction comprising Tween 80. Chang et al also teach adjust pH of the composition to 4-7.

"It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been

individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit since each is well known in the art for drug addiction. This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients, *In re Sussman*, 136 F.2d 715, 718, 58 USPQ 262, 264 (CCPA 1943). Accordingly, the instant claims, in the range of proportions where no unexpected results are observed, would have been obvious to one of ordinary skill having the above cited references before him.

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to combine the inventions of Zuo, Kim, Wen, Zhou, Oh, and Chang et al since all of them teach compositions for treating drug addiction individually in the art. Since all the compositions yielded beneficial results in treating drug addiction, one of ordinary skill in the art would have been motivated to make the modifications. It is well known in the art that *Amomum villosum* fruit, *Schizandra Chinese* fruit, and *Paeonia lactiflora* root are the parts of the herb that are being used. Regarding the limitation to the amount of the ingredients in the composition, the result-effective adjustment in conventional working parameters, is deemed merely a matter of judicious selection and routine optimization which is

well within the purview of the skilled artisan, which is dependent on the crop and amount of insect control that is needed.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Qiuwen Mi

Michele C. Flood.

MICHELE FLOOD
PRIMARY EXAMINER